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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,607	12/20/2001	Osamu Kato	NAGAT41.001AUS	4547

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/029,607

Applicant(s)

KATO, OSAMU

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-3 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
2. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-3 and 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - I. Regarding Claims 1 and 11, it is unclear what is meant by the phrase "contains, as resin,". Does this phrase mean that other resin materials are excluded?
  - II. Regarding Claim 2, it is unclear whether the phrase "chosen from a group of" is intended to set forth a listing of Markush group elements or not.
  - III. Regarding Claims 3 and 10, it is unclear whether these claims mean "said resin coating further contains" or something else?
  - IV. Regarding Claim 11, it is unclear whether the recited relative mass amounts refer to the composition of the finished coating composition or

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to the composition of a solution that is to be applied to the metallic plate material or both.

- V. Regarding Claims 12-15, it is unclear what is the antecedent basis of the phrase "the solid component." There is no mention of an earlier "solid component." It is unclear whether the recited relative mass amount refers to the composition of the finished coating composition or to the composition of a solution that is to be applied to the metallic plate material or both. It is unclear whether the recited relative mass amount is measured against the water component of the coating material or not. Is lubricant "solid component"?
- VI. Regarding Claim 15, it is unclear what is the mass percent basis. The percent of water is limited to 50 mass percent at most, and so it is unclear how the solid component could be only 40 mass percent.
- VII. Regarding Claims 18-21, it is unclear what is meant by the term "using." Does this entail more than "constructed from"?

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3, 11, 13, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. EPA 0 613 931 A2. Gosselin et al. teaches coating a metal sheet with an epoxy resin and chromium trioxide containing water dispersion, wherein the amount of water may range from 25 % by weight or more and wherein the composition may comprise minor amounts of wetting agent, i.e., surfactant, or wax, and wherein the film is described as having favorable lubricant properties. See Gosselin et al. (Abstract ; page 2, lines 33-56; page 3, lines 8-35 ; page 3, line 53 through page 4, line 3; and Claims). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply coatings having 25 –50 weight percent of water as Gosselin teaches that effective coating compositions may possess these amounts of water. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a surfactant in minor amounts as Gosselin teaches that including these ingredients is effective. It would have been obvious to one of

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ordinary skill in the art at the time of the invention to include wax in the composition of Gosselin in minor amounts as Gosselin teaches that including this ingredient is effective. It would be expected that such minor amounts would constitute less than 10 weight percent to constitute a minor amount. The claimed thicknesses are taught by the application amount of 0.7 g/m<sup>2</sup>. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply coatings with this areal density as Gosselin teaches that effective coatings are obtained with this coating thickness. Gosselin teaches that these coated steel sheets are generally applicable in automobile manufacturing. It would have been obvious to one of ordinary skill in the art at the time of the invention to use these sheets in automobile applications, which intrinsically may constitute an electronic instrument as automobiles possess electronic devices.

7. Claims 1, 3, 11, 13, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson USP 5,082,698. Anderson et al. teaches coating a metal sheet with an epoxy resin and chromium trioxide containing water dispersion, wherein the amount of water may range from 29 % by weight or more and wherein the composition may comprise minor amounts of butyl phosphoric acid wetting agent, i.e., surfactant, or vinyl fluoride polymer lubricant. See Anderson et al. (Abstract ; col. 3, line 7 through col. 4, line 13; col. 11, line 31 through col. 12, line 48; col. 12, lines 8-64; and col. 22, line 60 through col. 23, line 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply coatings having 29 –50 weight percent of water as

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Anderson teaches that effective coating compositions may possess these amounts of water. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a surfactant in minor amounts as Anderson teaches that including these ingredients is effective. It would have been obvious to one of ordinary skill in the art at the time of the invention to include vinyl fluoride lubricant in the composition of Anderson in minor amounts as Anderson teaches that including this ingredient is effective. The claimed thicknesses are taught by the application amount of 0.1 mil dry thickness, which would be expected to be obtained from a wet film within the claimed thickness range. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply coatings with this resulting dry thickness, and corresponding claimed wet thickness, as Anderson teaches that effective coatings are obtained with this coating thickness. Anderson teaches that these coated steel sheets are generally applicable in automobile and appliance manufacturing. It would have been obvious to one of ordinary skill in the art at the time of the invention to use these sheets in automobile or appliance applications, which intrinsically may constitute an electronic instrument as automobiles and appliances possess electronic devices.

### ***Conclusion***

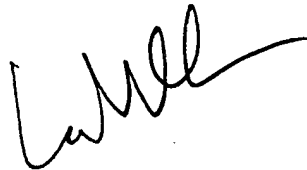
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is

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(703) 308-4428. The examiner can normally be reached on Monday through Friday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.
10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael La Villa  
August 7, 2003

A handwritten signature in black ink, appearing to read 'La Villa', written over the typed name and date.